

REMARKS

Claims 1-16 are currently pending in this application.

Applicants are pleased to note that the Examiner has indicated that claims 1-6 are allowable. Also, the Examiner has indicated that claims 8-10 would be allowable if rewritten in independent form to include all of the limitations of the base claim. Accordingly, claims 8-10 have been amended to be placed in independent form including all of the limitations of original claim 7. Applicants respectfully request that claims 8-10 be allowed.

Claim 7 has been amended to clarify that R¹ is a secondary alkyl group of 3 to 20 carbon atoms or a tertiary alkyl group of 4 to 20 carbon atoms.

Claims 12-16 have been rejected under 35 U.S.C. §112, second paragraph, for indefiniteness for allegedly reciting a use without any active, positive steps delimiting how this use is actually practiced. Also, claims 12-16 have been rejected under 35 U.S.C. §101 because the claimed recitation of a use, without setting forth any steps involved in the process, allegedly results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. §101.

Applicants respectfully traverse these §112, second paragraph and §101 rejections and request that the rejections be reconsidered and withdrawn.

Claims 12-16 have been amended to claim a combination of a phosphonium borate compound with a transition metal, transition metal salt, transition metal oxide or transition metal complex, rather than a use, without prejudice. Therefore, Applicants respectfully request that the §112, second paragraph and §101 rejections be reconsidered and withdrawn.

No new matter has been added to the application by the foregoing amendments.

Claim 7 has been rejected under 35 U.S.C. §102(e) as being anticipated by Lee et al., (U.S. Patent No. 7,294,600, same as WO 2004/087770). The Office Action alleges that Lee et al. discloses Applicants' claimed compounds, referring to the abstract.

Applicants respectfully traverse this rejection and request that the rejection be reconsidered and withdrawn.

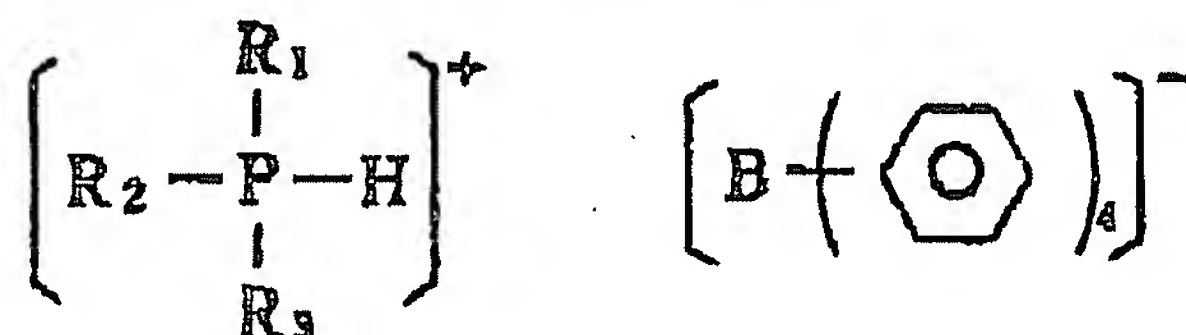
First, Applicants respectfully note that the abstract does not disclose any compounds.

Second, Applicants note that the present application claims priority from two

Japanese patent applications, namely JP 2003-399650 and JP 2003-399651, both filed on November 28, 2003. Applicants have attached hereto as Exhibit A an English language translation of priority document JP 2003-399650. Present claim 7 is literally supported at pages 1-2 (original claim 1) of this priority document. Since JP 2003-399650 supports the subject matter of claim 7, claim 7 is entitled to the priority date of November 28, 2003, which is earlier than the Lee et al. effective U.S. filing date (the PCT International filing date of March 24, 2004), thereby removing Lee et al. as a reference. Accordingly, Applicants respectfully request that the §102(e) rejection of claim 7 as being anticipated by Lee et al. (U.S. Patent No. 7,294,600) be reconsidered and withdrawn. Also, since the priority date of November 28, 2003 is prior to the international publication date of October 14, 2004 of WO 2004/087770, Applicants respectfully note that no new rejection based upon WO 2004/087770 should be asserted.

Claims 7 and 11 have been rejected under 35 U.S.C. §102(b) as being anticipated by Kinashi et al., (JP 62149721). The Office Action alleges that Kinashi et al. discloses Applicants claimed compounds, referring to pages 3 and 4.

Kinashi et al., (JP 62149721; D2) discloses a tetraphenylborate trialkylphosphine represented by the chemical Formula:



In the above Formula, R₁, R₂ and R₃ are alkyl radicals having 2-10 carbon atoms.

However, as the above compounds, D2 only specifically discloses that the compound having the radicals R₁ to R₃ are ethyl, butyl, hexyl, octyl or cyclohexyl; R₁ is ethyl and R₂-R₃ are butyl; R is butyl and R₂-R₃ are cyclohexyl; R₁ is cyclohexyl and R₂ - R₃ are butyl (see page 4, lines 4-7 of English translation of D2). More specifically, D2 discloses tributylphosphine tetraphenylborate (Example 1) and triethylphosphine tetraphenylborate (Example 3) as the tetraphenylborate trialkylphosphine compound. For your information, "tributylphosphine" in the last line of page 6 of English translation of D2 is a typographical error of "triethylphosphine".

Meanwhile, the novel phosphonium borate compound of the claim 7 of the present invention does not include the specific compounds exemplified in D2 since claim 7 as

amended specifies that R^1 is a secondary alkyl group of 3 to 20 carbon atoms or a tertiary alkyl group of 4 to 20 carbon atoms. Claim 11 depends from claim 7 and is distinguishable for the same reasons. Consequently, D2 does not adequately disclose the novel phosphonium borate compounds of claims 7 or 11 of the present invention represented by Formula (I) (R^1) (R^2) (R^3) $PH \cdot BAr_4$.

Therefore, Applicants respectfully request that the §102(b) rejection of claims 7 and 11 as being anticipated by Kinashi et al. be reconsidered and withdrawn.

Claim 7 has been rejected under 35 U.S.C. §102(b) as being anticipated by Gusev et al., (Synthesis, Structural Diversity, Dynamics, and Acidity of the M(II) and M(IV) Complexes $[MH_3(PR_3)_4] + (M = Fe, Ru, Os; R = Me, Et, \text{Journal of the American Chemical Society (1997), 119(16), 3716-3731})$. The Office Action alleges that Gusev et al. discloses Applicants claimed compounds, referring to the abstract.

Applicants respectfully traverse this rejection and request that the rejection be reconsidered and withdrawn.

Gusev et al., (D3) only discloses two compounds of tricyclohexylphosphonium tetraphenylborate and tri-tert-butylphosphonium tetraphenylborate as trialkylphosphonium tetraborate compounds (see left column of page 3731 of D3; "Preparation of $[HPR_3]BPh_4$ ($R = Cy, ^tBu$)").

Both of these two phosphonium borate compounds described in D3 are not included in the definition of phosphonium borate compounds of claim 7 of the present invention. Because in claim 7, R^1 to R^3 defined as " R^1, R^2 and R^3 cannot be tert-butyl groups simultaneously and Ar cannot be phenyl group at the same time; and R^1, R^2 and R^3 cannot be cyclohexyl groups simultaneously and Ar cannot be phenyl group at the same time".

Moreover, the novel phosphonium borate compounds of the present invention can be used together with transition metals, salts thereof, oxides thereof or complexes thereof in place of the transition metal complexes having phosphine ligands. D3 does not teach or suggest the use and effect of the novel phosphonium borate compounds of the present invention.

Therefore, Applicants respectfully request that the §102(b) rejection of claim 7 as being anticipated by Gusev et al. be reconsidered and withdrawn.

A catalog of "Air-stable, Non-pyrophoric Phosphine Ligand Precursors" existed at November 2003, however the exact issue date cannot be determined. Therefore,


Application No. 10/580,699
Paper Dated: July 11, 2008
In Reply to USPTO Correspondence of April 11, 2008
Attorney Docket No. 1217-061625

Applicants have listed the publication date as being November 2003 on the SB/08a form submitted herewith to ensure that this reference is considered.

Therefore, it is respectfully asserted that all of the pending claims comply with the requirements of §112 and §101 and are distinguishable from the cited references. Accordingly, Applicants respectfully request that this amendment be entered of record and considered, and that all of the pending claims be allowed.

Date: July 11, 2007

Respectfully submitted,
THE WEBB LAW FIRM

By 
Ann M. Cannoni
Registration No. 35,972
Attorney for Applicants
436 Seventh Avenue
700 Koppers Building
Pittsburgh, PA 15219
Telephone: (412) 471-8815
Facsimile: (412) 471-4094
E-mail: webblaw@webblaw.com